

### **REMARKS**

Claims 1-17 and 22-26 are pending in the present application.

Claims 18- 21 have been withdrawn from consideration by the examiner.

Claims 6, 7, 8 and 23 were amended. Applicants contend that support for such amendments can be found in Applicants original claims or, for example, at pages 7, 8 and 10 of Applicants' specification. Applicants request that the examiner peruse the amendments and such supporting materials.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### **RESTRICTION AND ELECTION OF SPECIES REQUIREMENT**

#### **I. Election With Traverse**

On April 2, 2004, Examiner Del Cotto telephoned Applicants' attorney. During such call the examiner separated the claims into Groups I (Claims 1-17 and 22-26) and Group II (Claims 18-21) from which Applicants were required to select one group for prosecution. During such call, Applicants provisionally elected Group I with traverse. Here, Applicants affirm such election with traverse.

#### **II. Basis For Traverse**

The Examiner contends that Groups I and II do not relate to a single general inventive concept as Groups I and II lack the same or corresponding technical features as Claim 1 is anticipated or obvious over Miracle et al. USP 5,576,282.

Applicants assert that Claim 1 is not anticipated or obvious in view of '282. In addition, even if Claim 1 were anticipated or obvious in view of '282, the remaining claims either claim or contain as an element an organic catalyst that is stable. Thus, all of Applicants' claims contain a common technical feature. Furthermore, Applicants assert that an art search for Group I would be expected to yield the art that is pertinent to the patentability of Group II. As a result of the foregoing, Applicants assert that the present restriction requirement should be withdrawn.

### III. Election Of Species With Traverse

During the April 2, 2004, telephone call, the examiner divided Formulas I-XX into ten groups and required Applicants to select one of such groups for prosecution. During such call, Applicants provisionally elected Group II which includes Formulas II and Formula XII with traverse. Here, Applicants affirm such election with traverse.

### IV. Basis For Traverse

The Examiner contends that Groups I and X do not relate to a single general inventive concept as Groups I and X lack the same or corresponding technical features as Claim 1 is anticipated or obvious over Miracle et al. USP 5,576,282.

Applicants assert that, as the species have a common activity – bleaching - pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(1)(A) the species are not properly subject to the aforementioned election requirement. As a result of the foregoing, Applicants assert that the present election of species requirement should be withdrawn.

### **ART REJECTIONS UNDER 35 USC § 102(b)**

According to MPEP § 2131 to anticipate a claim, the reference must teach every element of the claim. According to MPEP 2131.02 when the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated such that one of ordinary skill in the art can “at once envisage” the specific compound.

Furthermore, according to MPEP § 2112, when an Examiner asserts that an element is inherent the Examiner must provide rationale or evidence tending to show inherency. When attempting to meet such a burden, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Instead, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support such assertion. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In view of the aforementioned law, Applicants traverse the 35 U.S.C. § 102(b) rejections of their claims for the following reasons:

I. 102(b) Rejections Based On Miracle et al. (USP 5,576,282)

Claims 1-17 and 22-26 stand rejected as the Examiner contends that '282 discloses an organic catalyst and bleaching composition that meets all the limitations of Applicants' claims. Applicants traverse such rejection as, in addition to requiring specific catalyst lifetimes, amended Claims 1-17 and 22-26 require that each of the claimed or recited aryliminium cations and aryliminium polyions, aryliminium zwitterions, oxaziridinium cations and polyions, and oxaziridinium zwitterions comprise a moiety that is covalently bonded to the respective molecule's nitrogen and that such moiety have specific branching that is not taught or suggested by '282. Furthermore, even if such moiety could be found in '282, Applicants assert that a skilled artisan in possession of '282 would not "at once envisage" the specific molecules that are recited or claimed in Applicants' amended claims as '282 discloses a vast plethora of compounds but fails to provide sufficient insight to allow one skilled in the art to select and make the specific molecules that are recited or claimed in Applicants' amended claims.

As a result, the 35 U.S.C. § 102(b) rejection of Applicants' claims is not supported by '282. Thus, such rejection should be withdrawn.

II. 102(b) Rejections Based On Madison. (USP 5,817,614)

Claims 1-17 and 22-26 stand rejected as the Examiner contends that '614 discloses an organic catalyst and bleaching composition that meets all the limitations of Applicants' claims. Applicants traverse such rejection as, in addition to requiring specific catalyst lifetimes, amended Claims 1-17 and 22-26 require that each of the claimed or recited aryliminium cations and aryliminium polyions, aryliminium zwitterions, oxaziridinium cations and polyions, and oxaziridinium zwitterions comprise a moiety that is covalently bonded to the respective molecule's nitrogen and that such moiety have specific branching that is not taught or suggested by '614. Furthermore, even if such moiety could be found in '614, Applicants assert that a skilled artisan in possession of '614 would not "at once envisage" the specific molecules that are recited or claimed in Applicants' amended claims as '614 discloses a vast plethora of compounds but fails to provide sufficient insight to allow one skilled in the art to

select and make the specific molecules that are recited or claimed in Applicants' amended claims.

As a result, the 35 U.S.C. § 102(b) rejection of Applicants' claims is not supported by '614. Thus, such rejection should be withdrawn.

#### **ART REJECTIONS UNDER 35 USC § 102(b)/103(a)**

According to MPEP § 2143.03, to establish a case of prima facie obviousness, the cited art must teach or suggest all of an Applicant's claim limitations. According to MPEP § 2144.08(II) the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. See also, *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). Instead, some motivation to select the claimed species or subgenus must be taught by the prior art. See MPEP § 2144.08(II)(A)(4)(a). Furthermore, according to MPEP § 2141.02, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified."

In view of such law, Applicants traverse the 35 U.S.C. § 103(a) rejections of their claims for the following reasons:

Claims 1-17 and 22-26 stand rejected as the Examiner contends that separately or in combination '282 and '614 teach or suggest all the limitations of Applicants' claims and provide the motivation to do what Applicants have done. In addition to requiring specific catalyst lifetimes, Applicants' amended claims require that Applicants' that each of the claimed or recited aryliminium cations and aryliminium polyions, aryliminium zwitterions, oxaziridinium cations and polyions, and oxaziridinium zwitterions comprise a moiety that is covalently bonded to the respective molecule's nitrogen and that such moiety have specific branching. Applicants contend that such limitations are not taught or suggested by the art and that, even if such limitations were found in the art, that the art would not motivate the skilled artisan to select the subgenus that Applicants claim.

Furthermore, Applicants assert that the cited art fails to recognize that certain catalyst stability profiles may result in unacceptable effectiveness levels and fabric color damage (See page 2, of Applicants' specification). As Applicants recognized a source of such problems and provided a solution, and the cited art fails to recognize such source, the cited art cannot support a prima facie case.

As a result of the foregoing, Applicants assert that the 35 U.S.C. § 103(a) rejections of their claims should be withdrawn.

### **DOUBLE PATENTING**

Claims 1-17 and 22-26 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over:

- 1.) Claims 1-16 and 21-26 of co-pending application U.S. Serial No. 10/069,628;
- 2.) Claims 20-44 of co-pending application U.S. Serial No. 10/083,948;
- 3.) Claims 1-16 and 20-25 of co-pending application U.S. Serial No. 10/069,629;
- 4.) Claims 10, 29 and 60 of co-pending application U.S. Serial No. 10/069,630;
- 5.) Claims 1-16 and 18-23 of co-pending application U.S. Serial No. 10/069,633;
- 6.) Claims 20-44 of co-pending application U.S. Serial No. 10/069,631; and
- 7.) Claims 1-44 of co-pending application U.S. Serial No. 10/069,632.

According to MPEP § 804 (II)(B)(1) an obviousness-type double patenting rejection is appropriate only when the claimed subject matter is not patentable distinct from the subject matter claimed in a commonly owned patent or patent application. Furthermore, the analysis employed in making an obviousness-type double patenting rejection parallels that used to make a 35 U.S.C. § 103 obviousness determination, except that the claims of references applied need not actually be prior art. In the present case, the basis for the double patenting rejections is that the claims of the applied references encompass the material limitations of Claims 1-17 and 22-26.

In response to such rejections, Applicants asserts that the claims of the cited applications do not encompass all the material limitations of Applicants' claims as such claims do not contain the catalyst lifetime limitation of Applicants' claims or the branching limitation of such claims. Furthermore, the claims of the cited applications do not teach or suggest such limitations nor would they motivate one skilled in the art to produce the claimed catalyst and compositions comprising same as such claims do not teach or suggest the catalyst lifetime limitation of Applicants' claims or the branching limitation of such claims. As the double patenting references' do not render Applicants' amended claims obvious, such claims are patentably distinct. Thus, Applicants respectfully asserts that the double patenting rejection should be withdrawn.

### **CONCLUSIONS**

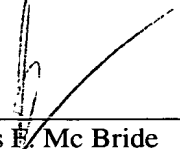
Appl. No. 10/069,634  
Atty. Docket No. 7752M  
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In view of the amendments and remarks presented herein, Applicants respectfully request that the restriction requirement be withdrawn and Claims 1-26 be allowed. In the event there are remaining issues, the Examiner is invited to call Applicants' undersigned attorney to discuss such issues.

Respectfully submitted,

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